

REMARKS

I. Introduction

Claims 3, 8, 20, 22 and 26-27 are pending in the present application after cancellation of claims 1-2, 4-6, 9-19, 21 and 23-25. Applicant thanks the Examiner for allowing claim 3.

II. Rejection of Claims 1, 2, 4, 8 and 20-27 under 35 U.S.C. § 103(a)

Claims 1, 2, 4, 8 and 20-27 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese Patent No. 590113421 ("Utagawa") in view of U.S. Patent No. 5,231,534 ("Kato"). Applicant notes that claims 1, 2, 4, 21 and 23-25 have been canceled. Applicant respectfully traverses the rejection with respect to claims 8, 20, 22 and 26-27 for the following reasons.

In rejecting a claim for obviousness under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine the reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 8 recites, in relevant parts, "the first optical element is constructed as a **prism, arranged to be contacted, at an exit surface thereof, with the chemical substance.**" Although Fig. 10 of Utagawa shows a configuration in which chemical substance is contacted with a reflecting surface of the prism, none of the applied references discloses or suggests a configuration in which the chemical substance is contacted with an exit surface of a prism. Therefore, claim 8 and its dependent claim 20 are clearly not rendered obvious by the applied prior art, and thus the obviousness rejection with respect to claim 8 should be withdrawn.

Claim 22 recites that the condition " $F > a$ ($a \leq 3.5/\mu m$)" is satisfied for "the optical system and the electronic imaging element." Regarding this recited numerical condition, which is also recited in allowed claim 3, the Examiner states that "the prior art fails to teach

or suggest the claimed relationship between the F value and the pixel pitch as claimed."

Therefore, Applicant notes that claim 22 is allowable for the same reason as claim 3. Claims 26 and 27, which depend from claim 22, also are allowable.

For at least the foregoing reasons, the obviousness rejection of pending claims 8, 20, 22 and 26-27 should be withdrawn.

III. Conclusion

For the preceding reasons, it is respectfully submitted that all the outstanding rejections have been overcome and that the application is in condition for allowance.

Respectfully submitted,

Dated: November 15, 2007

By: 

Jong H. Lee
(Reg. No. 36,197)
KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200
CUSTOMER NO. 26646